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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,750	08/03/2001	Jeffrey H. Diamond	0136.0003C	5953

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EXAMINER

A, PHI DIEU TRAN

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,750

Applicant(s)

DIAMOND, JEFFREY H.

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24,28-39,51-57 and 59-62 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,23,24,33 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-19,22,28-32,35,39,51-57 and 59-62 is/are rejected.
- 7) ☒ Claim(s) 20,21 and 36-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/2/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. PRODUCT BY PROCESS CLAIM:

"The subject matter present in claim 18 is regarded as a product by process claim in which a product is introduced by the method in which it is made. It is the general practice of this office to examine the final product described regardless of the method provided by the applicant."

The above office policy applies to the limitation "is applied ...fluidic form...cohesive mass" in claim 18 and is reflected in the rejection below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 5, 18, 22, 28, 35, 39, 51, 53-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohayon (GB2208073).

Ohayon discloses a stabilized window structure (the structure to the mirror glass meets the claimed limitations to the window structure and thus read on the window structure) comprising a window frame (mirror housing), a shattered window pane (figure 1) disposed in the window frame and having an exterior surface and an interior surface exposed by the window frame, the interior surface being opposite the exterior surface, a layer of unifying material (the removable adhesive tape) adhesively bonded to a substantial portion of at least one of the exterior surface or said interior surface, the layer of unifying material and the window pane bonded thereto forming an integral, cohesive mass in which the shattered window pane is structurally united, the mass being removable from the window frame as one or more integral and unitary pieces, the window pane being non-planar (page 12 line 1), the frame is disposed in a

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vehicle, the layer of unifying material is disposed over substantially the entirety of the at least one of the exterior surface.

Per claims 28, 35, 39, 51, 53-55 Ohayon discloses all the claimed method steps. With respect to claims 53, 54, the bonding process in Ohayon inherently functions as claimed.

3. Claims 56-57, 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al (6067819).

Tanaka et al (figure 4^e) shows a protected window pane comprising a window pane having an exterior surface and an interior surface, a layer of polymeric foam disposed on at least one of the exterior surface or the interior surface to provide protection to the window pane, the foam and the window pane forming a protected window pane, at least one handle (34) secured to the pane by adhesion (33) of the at least one handle with the foam, the adhesion being provided in the foam, the handle including a plurality of handles (the different parts making up part 34), the layer is bonded to the window pane by adhesion provided by the foam.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-17, 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohayon (GB2208073).

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Ohayon shows all the claimed limitations except for the polymeric material being polymeric foam including polyurethane, polyethylene, or polystyrene, the polymeric material being a polymeric film including polyvinyl, a latex, polyurethane, acrylate or cellophane, the material being cellulosic material.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ohayon's adhesive to show the adhesive being a polymeric material, the polymeric material being a polymeric foam including polyurethane, polyethylene, or polystyrene, the polymeric material being a polymeric film including polyvinyl, a latex, polyurethane, acrylate or cellophane, the material being cellulosic material because it has been held to be within the general skill of a worker in the art to select a known material on the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

Per claims 30-32, Ohayon as modified shows all the claimed limitations. The claimed method steps would have been the obvious method steps of stabilizing and removing Ohayon's shattered window pane.

6. Claims 18-19, 29, 52, 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohayon (GB2208073) in view of Woodhall et al (5739191).

Ohayon shows all the claimed limitations except for the material being applied the window in fluidic form and cures to form the cohesive mass.

Woodhall et al discloses a adhesive material being attached to a glass pane by spraying and brushing.

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It would have been obvious to one having ordinary skill in the art at the time of the invention modify Ohayon to show the material being in applied in fluidic form and cures to form the cohesive mass as taught by Woodhall et al because applying an adhesive to a pane surface in the form of fluid by spraying, brush, dipping, or adhesive tape etc... are known ways of covering/bonding the pane surface to the adhesive as they enable easy application of the adhesive to the pane surface.

Per claim 19, Ohayon as modified inherently show the material seeping into the cracks in the pane as fluid naturally flows into the cracks in the applied pane surface.

Per claims 29, 52, 60-62, Ohayon as modified by Woodhall et al shows all the claimed limitations. The claimed method steps would have been the obvious method steps of stabilizing and removing the window pane from the window frame.

Allowable Subject Matter

7. Claims 20-21, 36-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: prior art does not show a stabilized window structure comprising a window frame, a shattered window pane in the frame, a layer of material adhesively bonding to a substantial portion of the exterior surface or interior surface, the material forming an integral cohesive mass in the which the shattered window pane is structurally united, the mass being removable from the window frame as one or more integral and unitary pieces, and at least one grasping member secured to

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the cohesive mass; prior art also does not provide sufficient motivation to modify Ohayon to show the window frame having a grasping member secured to the cohesive mass in combination with other claimed limitations.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 3, 5-22, 28-32, 35-39, 51-57, 59-62 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different methods of protecting a window pane.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phi Dieu Tran A

5/7/04